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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,668	02/13/2002	Alan E. Shluzas	A31-6014	2672
26294	7590	08/26/2004	EXAMINER	
TAROLLI, SUNDHEIM, COVELL & TUMMINO L.L.P. 526 SUPERIOR AVENUE, SUITE 1111 CLEVEVLAND, OH 44114				RAMANA, ANURADHA
ART UNIT		PAPER NUMBER		
3732				

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/075,668	SHLUZAS, ALAN E.
	Examiner	Art Unit
	Anu Ramana	3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 22 July 2004.
- 2a) This action is FINAL.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-5, 7-29 and 31-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 48 is/are allowed.
- 6) Claim(s) 1-5, 7-29, 31-47 and 50-59 is/are rejected.
- 7) Claim(s) 49 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on February 13, 2002 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 22, 2004 has been entered.

### *Claim Objections*

Claim 49 is objected to because of the following informalities. In lines 29-31, "An .....other." Appears to be extraneous text. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7-12 and 14-29, 31-47 and 50-59 are rejected under 35 U.S.C. 102(b) as being anticipated by Farris et al. (US 6,485,491).

Farris et al. disclose an apparatus 20 including: a housing 22d; a longitudinal member 36 received in a first opening of housing 22d; a washer or spacer 26d with received in a first opening of housing 22d; a fastener 24 engageable with a bone portion to connect member 36 to the bone portion wherein fastener 24 has a first part spherical surface engageable with housing 22d and a second part spherical surface engageable with spacer 26d; a snap-ring or "compressible member" or "spring member" 28' having a curved or "arched" configuration and a gap; and a clamping mechanism or set screw 30 that clamps longitudinal member 36 in housing 22d (Figures 1, 17 and 53, col. 5, lines 9-15, col. 6, lines 4-39 and lines 54-67, col. 7, lines 1-43 and col. 11, lines 6-44).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Farris et al. in view of Jepson et al. (US 5,135,489).

Although Farris et al. do not disclose slots on spacer 26d, it is the Examiner's position that providing axial slots on the outer surface of a body to enhance gripping of a body by a tool or hand are well known as evidenced by Jepson et al. (US 5,135,489) (see Figure 48 and col. 18, lines 46-49).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided slots on the outer surface of spacer 26d of Farris et al. to enhance gripping of the spacer since it was known in the art to provide slots on the outer surface of a body to enhance gripping of a body. It is noted that the phrase "that receive a tool for inserting said spacer into said housing" is deemed to be a functional recitation and has thus not been given any patentable weight.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 8-12, 14-16, 24, 32-36 and 38-41 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8-15, 32-40 and 41 of copending Application No. 10/087,489. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the claims of the present application and the claims of the copending application is that the claims of the copending application include many more elements and are thus more specific. Thus the invention of the claims of copending application 10/087,489 is in effect a “species” of the “generic” invention of the claims of the present application. It has been held that the generic invention is “anticipated” by the “species.” See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the claims of the present application are anticipated by the claims of the copending application, they are not patentably distinct from the claims of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### *Response to Arguments*

Applicant's arguments submitted under “REMARKS” in the response submitted on July 22, 2004 have been fully considered but are not persuasive with respect to claims 1-5, 7-29, 47 and 50-59. Applicant's arguments are persuasive with respect to the rejections of claims 41-44 under 35 U.S.C. 112, second paragraph. Accordingly, these rejections are being withdrawn.

Applicant's arguments that Farris et al. do not describe or suggest a member applying an axial force to prevent relative movement between a fastener and a housing when the longitudinal member is disengaged from the spacer and the spacer engages the fastener are not persuasive. Farris et al. disclose a non-planar snap ring 28' having a curved or “arched” configuration that could have extending finger-spring elements such that the snap ring 28' allows less play between housing 22, anchoring member 24 and a washer or spacer 26 (see col. 7, lines 32-43). In Fig. 53, the snap ring 28 is clearly shown engaging the spacer 26d when placed in a groove 48d of housing 22d. A non-planar snap ring 28' when placed in groove 48d of housing 22d would inherently apply an axial force on spacer 26d due to its curved configuration.

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Regarding claim 13, in response to Applicant's argument that there is no suggestion to combine Farris et al. and Jepson et al., the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). In this case, Jepson et al. clearly shows axial slots on a body for enhancing gripping of the body by a tool or any other means. Thus a person of ordinary skill in the art at the time the invention was made would have been motivated to provide slots on the Farris et al. spacer 26d to enhance gripping of the spacer.

#### *Allowable Subject Matter*

Claim 48 is allowed.

Claim 49 would be allowable if the objection made in this office action is overcome.

#### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (703) 306-4035. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR *Anuadhe Ramana*  
August 23, 2004

*Kevin Shaver*  
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